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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|--------------------|
| 10/069,001 | 02/20/2002 | Yuji Sawada | 0992-0127P | 4536 |
| 2292 | 7590 | 01/07/2005 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH | | | | ALEJANDRO, RAYMOND |
| PO BOX 747 | | | | |
| FALLS CHURCH, VA 22040-0747 | | | | |
| ART UNIT | | PAPER NUMBER | | |
| | | 1745 | | |

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--|-------------------|---------------|
| | Application No. | Applicant(s) |
| | 10/069,001 | SAWADA ET AL. |
| | Examiner | Art Unit |
| | Raymond Alejandro | 1745 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 October 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,5,8,9,14,16 and 25-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1, 5, 8-9, 14, 16 and 25-27 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/04 has been entered.

This is responsive to the foregoing RCE and its related amendment. The applicants have overcome the objection. Refer to the aforementioned amendment for specific details on applicant's rebuttal arguments. However, the claims are finally rejected over the same art as seen below and for the reasons of record:

Election/Restrictions

2. Applicant's cancellation of claims 2, 4, 7, 10-13, 15, 17-24 and 28-29 is acknowledged.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 5, 8-9, 14, 16 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese document JP 11-086808 (herein called “*the JP’808 document*”) in view of the Japanese publication JP 09-283101 (hereinafter referred to as “*the JP’101 publication*”).

The present application is directed to a laminate for sealing a battery electrolyte or electrode wherein the disclosed inventive concept comprises the specific laminate structure.

With reference to claims 1, 14 and 16:

The JP’808 document discloses a sealing bag for nonaqueous electrolyte battery, the sealing bag seals the positive and negative electrodes and the electrolyte (Title/Abstract). *Thus, the layered sealing bag meets the requirement of being a seal film for sealing a battery component such as an electrolyte or an electrode.*

1st Examiner’s note: *as to the specific preamble reciting “for use as a seal film for sealing an electrolyte of a battery or as a protective film for protecting an electrode of a battery”, it is pointed out that the preamble refers to intended use. That is, the claim is directed to a laminate per se and the foregoing preamble phrase is only a statement of ultimate intended utility.*

2nd Examiner's note: the limitation "an oxidatively or chemically surface-treated metal layer" is being construed as product-by-process limitation and therefore, it is contended that the product itself does not depend on the process of making it. Accordingly, in a product-by-process claim, the patentability of a product does not depend on its method of production. In that, it is further noted that the product in the instant claims is the same as or obvious over the product of the prior art.

It is disclosed that the sealing bag is formed with a material stuck together with plastic layers inserted with a metal layer such as aluminum foil and a metal deposition layer, a PET film is stuck thereto and a thermoplastic resin such as polyethylene is also stuck thereto (Abstract/Solution). **Figure 3** below illustrates the specific layered structure of the sealing feature, particularly, the Al foil 9, the plastic layers 11 and the heat seal layers 10.

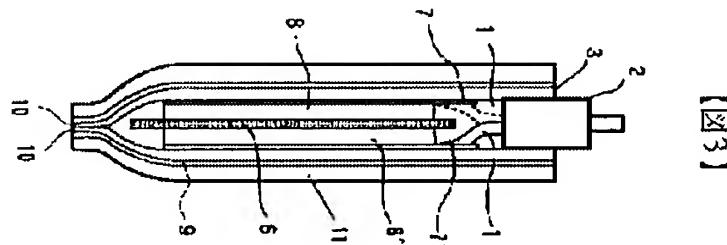


TABLE 1 below shows the specific constitution of sealing bag including: the PET layer, an urethane adhesive, the Al foil, the acid-modified LDPE, and the heat seal layers Y and Z.

| 【表1】 封入袋のシート構成 | |
|-------------------|--------------|
| PET | (12 μ m) |
| ウレタン系接着剤 | (5 μ m) |
| アルミ箔 | (9 μ m) |
| 酸変成LDPE | (20 μ m) |
| ヒートシール層Y | (30 μ m) |
| ヒートシール層Z | (30 μ m) |

With respect to the surface treated layer: the JP'808 document also discloses that the sealing bag 3 preferably comprises a laminated material comprising a substrate having a metallic

vapor deposition layer sandwiched between plastic layers 10 and 11 (SECTIONS 0010-0015).

Thus, the substrate itself having the metallic vapor deposition layer acts as the surface-treated layer over the substrate surface. Furthermore, it is also disclosed that the plastic film 11 and the metallic foil layer 9 are adhered to each other by using adhesive, such as urethane, epoxy and polyester resins (SECTIONS 0010-0015). *Hence, the foregoing adhesive layer, to some extent, chemically treat the surface of the Al foil or the metallic layer.*

With respect to the layer of an adhesive resin: it is disclosed that the acid-modified LDPE is an acid-modified polyolefin being modified by a carboxylic acid (SECTIONS 0010-0015).

As to claim 5:

The JP'808 document discloses the metal layer is made of aluminum foil (ABSTRACT/SOLUTION).

On the matter of claims 8-9:

It is disclosed that resin composition used for a plastic layer is mainly made of acid-denatured polyethylene or acid-denatured polypropylene (ABSTRACT/SOLUTION). It is disclosed that the acid-modified LDPE is an acid-modified polyolefin being modified by a carboxylic acid (SECTIONS 0010-0015).

The JP'808 document discloses a layered laminate made of a seal film according to the foregoing aspects. However, the JP'808 does not expressly disclose the specific chemically surface-treated layer.

As to claims 1, 25-27:

The JP'101 publication reveals a sealing bag using maleic acid modified polyolefine as a material for a seal part of a sealing bag, and providing a maleic acid modified polyolefine layer therein (ABSTRACT).

Examiner's note: additionally, as to the limitation, "an oxidatively or chemically surface-treated metal layer", it is noted that a method limitation incorporated into a product claim does not patentable distinguish the product because what is given patentably consideration is the product itself and not the manner in which the product was made. Therefore, the patentability of a product is independent of how it was made. This is to address the limitations reciting the specific chemical treatment material/technique: even though the limitation "a surface-treated layer formed...by chemical or oxidative treatment of the metal" may impart, somehow, a different structure (the one formed by the specific surface-treated layer), it is noted that as long as the surface thereon is chemically or oxidatively treated, the present claims satisfy the intended invention of having a chemical-oxidative surface treated layer. Thus, the chemically/oxidatively surface treated layer is formed thereon regardless of the specific chemical treatment material or technique.

In view of the above, it would have been obvious to one skilled in the art at the time the invention was made to use the specific chemically surface-treated layer of the JP'101 publication in the layered seal-forming laminate of the JP'808 document as the JP'101 publication discloses the use of a maleic acid modified polyolefine layer provides a bag with high reliability of sealing. Thus, the JP'101 directly teaches the advantage of using the specific chemically surface-treated layer as instantly claimed. Moreover, it has been held that re-arrangement, reversal or duplication of parts is obvious. Succinctly stated, fact that a claimed feature is structurally re-

arranged, reversed or duplicated is not sufficient by itself to patentably distinguish over an otherwise old feature unless there are new or unexpected results as it is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed layered laminate was significant. In re Japikse 86 USPQ 70. In re Gazda 104 USPQ 400. In re Harza 124 USPQ 378.

Response to Arguments

6. Applicant's arguments filed 10/13/04 have been fully considered but they are not persuasive.
7. The principal contention of applicants' arguments is premised on the assertion that the prior art of record does not disclose/involve "*the use of an oxidatively or chemically surface-treated metal as required by applicants' claimed invention*". However, this assertion is still insufficient to overcome the rejection. First of all, the rejected claims have been now construed as being directed to a product-by-process recitation. In this regard, although applicants are entitled to define a product by using process/method limitations, what is given patentably consideration is the product itself and not the manner in which the product was made. In this case, the combined prior art teaches: a maleic acid-modified polyolefin over the metal layer which also have deposited thereon another resin layer. In consequence, the references are teaching substantially the same product and constituents as the product made by the product-by-process limitation of the instant claims. Therefore, the patentability of a product is independent of how it was made. However, there may be situations when the manner in which a product was made should be given consideration. Thus, burden is on applicants to show differences in product-by-process claims as well as in product comparisons. Further, even though the prior are

may fail to disclose other physical properties, in view of the substantially similar products being disclosed in the instant application, the examiner has a reasonable basis to suspect that the claimed product and the combined prior art's layered structure would be substantially the same. Since PTO does not have proper equipment to carry out the analytical tests, the burden is then shifted to applicants to provide objective evidence demonstrating the claimed product is necessarily different from the prior art's product, and that the difference is unobvious (*Refer to MPEP 2113: Product-by-Process Claims*). Accordingly, applicants have not provided yet objective or factual evidence such as unexpected results and/or a structure comparison to show how the present claims patentably differentiate from the applied-combined prior art. In the event applicants further argue that "*an oxidatively or chemically surface-treated* metal layer" is structurally different, it is contended that applicants have failed to state how the implied manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223.

Accordingly, the examiner also asserts that it is not enough that applicant's representative personally believes that the presently claimed invention and the combined prior art are different. That is to say, the arguments of counsel cannot take the place of evidence in the record. An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of product-by-process analysis (See **MPEP 716.01 and 2145: Consideration of Applicant's Rebuttal Arguments**).

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. a) "*This result is attained by oxidatively or chemically surface treating the surface of the metal layer prior to*

application of a specific resin for the resin layer"; b) "an inert protective or passive film is formed on the metal surface") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the present claims are completely silent as to having "an additional inert protective/passive film" on the metal surface. Furthermore, it is also unclear whether applicants are now intending to recite: 1) a metal layer which has been surface treated only; b) a metal layer containing an inert protective/passive film; and/or c) all of the above (a + b). Thus, further clarification is required.

9. In response to applicant's argument that: *a) "...that adhesive resin layer is enhanced upon immersion in an electrolyte when an oxidatively or chemically surface-treated metal layer is used..."; b) "that the reliability of sealing tightness of the heat seal part or a lead wire guide-out site of a sealing bag for a battery cell unit is facilitated...[in the prior art]"*, the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (571) 272-1282. The examiner can normally be reached on Monday-Thursday (8:00 am - 6:30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond Alejandro
Examiner
Art Unit 1745

A handwritten signature in black ink, appearing to read "RAYMOND ALEJANDRO", is positioned to the right of the typed name. It is written in a cursive style with a diagonal line through it.